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09/839,231	04/23/2001	Takehisa Yamaguchi	54024-030	4039
7590 02/15/2006 McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005			EXAMINER VU, NGOC K	
			ART UNIT	PAPER NUMBER
			2611	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,231

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Ngoc K. Vu

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 40-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-39 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/23/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 11 is objected to because of the following informalities: it is unclear whether the limitations "receiver" in lines 4 and 8 are the same. Appropriate correction is required. Examiner considers that the limitations "receiver" in lines 4 and 8 are the same with respect to the specification for the examination purpose only.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 9-12, 17-20, 22, 25, 30, 31, 33, 35, 36, 38 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Del Castillo (U.S. 6,742,188 B1).

Regarding claim 1, Del Castillo teaches a broadcasting system (see figures 5-8) comprising: a broadcasting device (i.e., 76) for transmitting broadcasting waves; a receiver (i.e., 90) for receiving said broadcasting waves; and a peripheral device (i.e., 60) provided outside said receiver, said broadcasting device comprising a transmission controller (within 76) for transmitting a combination of broadcast data about a broadcast program and an external control signal for controlling said peripheral device in accordance with contents of said broadcast program in the form of said broadcasting waves to said receiver (see 11, lines 37-39; col. 14, lines 33-35; col. 15, line 63 to col. 16, line 15; col. 16, lines 3-6; col. 16, lines 63 to col. 17, line 24), said receiver (90) comprising a receiver controller (i.e., 91) for receiving said broadcasting

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waves from said broadcasting device to output said broadcast data to a reproducer (i.e., 57) and to transmit a command signal dependent on said external control signal to said peripheral device (60) (see col. 15, lines 56-67; col. 18, lines 13-17), said peripheral device being controlled by said command signal (see col. 11, lines 37-39; col. 15, line 63 to col. 16, line 15).

Regarding claim 2, Del Castillo teaches that said peripheral device includes a sound generator (within 60) (see col. 16, lines 4-47).

Regarding claim 9, Del Castillo teaches that said peripheral device includes a toy device (60) relating to a character, and said external control signal includes information for operating said toy device in response to an operation of said character appearing in said broadcast program (see col. 15, lines 63-67 and figure 4).

Regarding claim 10, Del Castillo teaches that said peripheral device includes a toy device (60) relating to a character, wherein said toy device comprises a voice storage (within 61-67), and wherein said external control signal includes: a voice signal representative of a voice emitted by said character appearing in said broadcast program; and a storage command signal for instructing said toy device to store said voice signal in said voice storage (providing the control data included instructions to cause device 60 to talk as though it is a character in the audio/video presentation – see col. 11, lines 29-39; col. 16, lines 42-50).

Regarding claim 11, Del Castillo teaches a system (see figures 5-8) in which a broadcast program transmitted from a broadcasting device (i.e., 76) is received by a receiver (i.e., 90) associated with a peripheral device (i.e., 60), said system comprising: broadcasting device for transmitting broadcasting waves to a receiver, said broadcasting waves including broadcast data about said broadcast program and an external control signal for controlling said peripheral device in accordance with contents of said broadcast program (see 11, lines 37-39; col. 14, lines 33-35; col. 15, line 63 to col. 16, line 15; col. 16, lines 3-6; col. 16, lines 63 to col. 17, line

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24); and a receiver (90) for receiving said broadcasting waves from said broadcasting device to output said broadcast data to a reproducer (i.e., 57) and to transmit a command signal dependent on said external control signal to said peripheral device (see col. 15, lines 56-67; col. 18, lines 13-17).

Regarding claim 12, Del Castillo teaches that said peripheral device includes a a toy device relating to a character (see col. 15, lines 63-67).

Regarding claim 17, Del Castillo teaches that said peripheral device includes a toy device (60) relating to a character, and said external control signal includes information for operating said toy device in response to an operation of said character appearing in said broadcast program (see col. 15, lines 63-67 and figure 4).

Regarding claim 18, Del Castillo teaches that said peripheral device includes a toy device (60) relating to a character, wherein said toy device comprises a voice storage (within 61-67), and wherein said external control signal includes: a voice signal representative of a voice emitted by said character appearing in said broadcast program; and a storage command signal for instructing said toy device to store said voice signal in said voice storage (providing the control data included instructions to cause device 60 to talk as though it is a character in the audio/video presentation – see col. 11, lines 29-39; col. 16, lines 42-50).

Regarding claim 19, Del Castillo teaches a broadcasting device (76) for transmitting broadcasting waves to a receiver (90) provided with a peripheral device (60), said broadcasting device comprising: an element (within 76) for generating a combined signal including broadcast data about a broadcast program and an external control signal for controlling said peripheral device in accordance with contents of said broadcast program; and a transmitter (within 76) for transmitting said combined signal as said broadcasting waves (see col. 11, lines 37-39; col. 14, lines 33-35; col. 15, line 63 to col. 16, line 15; col. 16, lines 3-6; col. 16, lines 63 to col. 17, line

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24; col. 17, lines 12-15).

Regarding claim 20, Del Castillo teaches that said peripheral device includes a toy device relating to a character (see col. 15, lines 63-67).

Regarding claim 22, Del Castillo teaches a receiver (90) for receiving broadcasting waves transmitted from a broadcasting device (76), said broadcasting waves including broadcast data about a broadcast program and an external control signal for controlling a peripheral device (60) in accordance with contents of said broadcast program, said receiver comprising: a receiver element (within 91) for receiving said broadcasting waves; an output element (within 91) for outputting information obtained based on said broadcast data to a reproducer (57); and a transmission element (96) for transmitting a command signal dependent on said external control signal to said peripheral device (see figures 6 and 8; col. 15, line 22 to col. 16, line 15; col. 11, lines 37-39; col. 14, lines 33-35; col. 16, lines 63 to col. 17, line 24; col. 17, lines 12-15).

Regarding claim 25, Del Castillo teaches a peripheral device (60) capable of communicating with a broadcast receiver (90), said broadcast receiver receiving broadcasting waves including a combination of broadcast data about a broadcast program and an external control signal for controlling said peripheral device in accordance with contents of said broadcast program, said peripheral device comprising: a receiver element (67) for receiving said external control signal from said broadcast receiver; and an operation element (61, 69) for operating in response to said external control signal (see figures 6-8; col. 15, line 22 to col. 16, line 15; col. 11, lines 37-39; col. 14, lines 33-35; col. 16, lines 63 to col. 17, line 24; col. 17, lines 12-15).

Regarding claim 30, Del Castillo teaches a method of transmitting and receiving a broadcast program, comprising the steps of: transmitting from a broadcasting device (76) a

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combination of broadcast data about a broadcast program and an external control signal for controlling a peripheral device (60) attendant on a receiver (90) in accordance with contents of said broadcast program in the form of broadcasting waves; receiving said broadcasting waves at said receiver to output said broadcast data to a reproducer (57) and to transmit a command signal dependent on said external control signal to said peripheral device (see figures 6 & 8; col. 15, line 22 to col. 16, line 15; col. 11, lines 37-39; col. 14, lines 33-35; col. 16, lines 63 to col. 17, line 24; col. 17, lines 12-15); and controlling said peripheral device by using said command signal (see col. 11, lines 37-39; col. 15, line 63 to col. 16, line 15).

Regarding claim 31, Del Castillo teaches that said peripheral device includes a a toy device relating to a character (see col. 15, lines 63-67).

Regarding claim 33, Del Castillo teaches that said peripheral device includes a toy device (60) relating to a character, and said external control signal includes information for operating said toy device in response to an operation of said character appearing in said broadcast program (see col. 15, lines 63-67 and figure 4).

Regarding claim 35, Del Castillo teaches a method of broadcasting for execution with a broadcasting device (76), comprising the steps of: obtaining a combined signal including broadcast data about a broadcast program and an external control signal for controlling a peripheral device (60) attendant on a receiver (90) in accordance with contents of said broadcast program; and transmitting said combined signal in the form of broadcasting waves from said broadcasting device (see figures 6 & 8; col. 15, line 22 to col. 16, line 15; col. 11, lines 37-39; col. 14, lines 33-35; col. 16, lines 63 to col. 17, line 24; col. 17, lines 12-15).

Regarding claim 36, Del Castillo teaches that said peripheral device includes a a toy device relating to a character (see col. 15, lines 63-67).

Regarding claim 38, Del Castillo teaches that said peripheral device includes said toy device, and said external control signal includes information for operating said toy device in response to an operation of said character appearing in said broadcast program (see col. 15, lines 63-67).

Regarding claim 39, Del Castillo teaches that said peripheral device includes a toy device (60) relating to a character, wherein said toy device comprises a voice storage (within 61-67), and wherein said external control signal includes: a voice signal representative of a voice emitted by said character appearing in said broadcast program; and a storage command signal for instructing said toy device to store said voice signal in said voice storage (providing the control data included instructions to cause device 60 to talk as though it is a character in the audio/video presentation – see col. 11, lines 29-39; col. 16, lines 42-50).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-16, 21, 23, 24, 26-29, 32, 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Del Castillo (U.S. 6,742,188 B1) in view of Allport (US 6,097,441 A).

Regarding claim 13, Del Castillo teaches that said receiver comprises receiver element (within 91) for receiving a plurality of broadcasting waves transmitted from said broadcasting device; a memory element (92) for storing a plurality of external control signals included respectively in said plurality of broadcasting waves; a channel-selection element (within 91) for

extracting said broadcast data included in a broadcasting wave for a channel designated by said peripheral device from said plurality of broadcasting waves; an extraction element (within 99 & 93) for extracting an external control signal included in the broadcasting wave for the channel selected by said channel-selection element from said plurality of external control signals stored in said memory element; and a transmission element (96) for transmitting said external control signal extracted by said extraction element to said peripheral device (see figures 6 and 8; col. 15, line 22 to col. 16, line 15).

Del Castillo does not teach the features of remote controller as claimed with further regarding to claims 13 -15. However, a system of Allport includes a remote control 10 comprising LCD display 380 and touch screen 375 as shown in figures 1, 2 and 4 (see figures 1, 2 and 4; col. 15, lines 25-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Del Castillo by including a remote control having LCD display and touch screen as taught by Allport in order to achieve enhanced viewing and/or browsing of data on the remote control.

Further regarding claim 15, the combined system of Del Castillo and Allport further teaches that the remote controller is configured to transmit inputted information to provider through receiver (see Allport: col. 12, lines 11-44; col. Del Castillo: col. 16, lines 51-61).

Regarding claim 16, Neither Del Castillo nor Allport teach voice information inputted from a voice input device. Official Notice is taken that a remote control includes a voice input device for input voice command or information is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Del Castillo and Allport by inputting voice information via a voice input device of the remote control for input voice command or information.

Regarding claims 21, 23 and 24, Del Castillo does not teach the features of remote controller as claimed. However, a system of Allport includes a remote control 10 comprising LCD display 380 and touch screen 375 as shown in figures 1, 2 and 4 (see figures 1, 2 and 4; col. 15, lines 25-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Del Castillo by including a remote control having LCD display and touch screen as taught by Allport in order to achieve enhanced viewing and/or browsing of data on the remote control.

Further regarding claim 24, Del Castillo teaches that said receiver comprises receiver element (within 91) for receiving a plurality of broadcasting waves transmitted from said broadcasting device; a memory element (92) for storing a plurality of external control signals included respectively in said plurality of broadcasting waves; a channel-selection element (within 91) for extracting said broadcast data included in a broadcasting wave for a channel designated by said peripheral device from said plurality of broadcasting waves; an extraction element (within 99 & 93) for extracting an external control signal included in the broadcasting wave for the channel selected by said channel-selection element from said plurality of external control signals stored in said memory element; and a transmission element (96) for transmitting said external control signal extracted by said extraction element to said peripheral device (see figures 6 and 8; col. 15, line 22 to col. 16, line 15).

Regarding claims 26 and 27, Del Castillo does not teach the features of remote controller as claimed. However, a system of Allport includes a remote control 10 comprising LCD display 380 and touch screen 375 as shown in figures 1, 2 and 4 (see figures 1, 2 and 4; col. 15, lines 25-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Del Castillo by including a remote control having LCD display and touch screen as taught by Allport in order to achieve enhanced

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viewing and/or browsing of data on the remote control. The combined system of Del Castillo and Allport further teaches that the remote controller is configured to transmit inputted information to receiver (i.e., to swap the programs being displayed on TV and the remote control's display) (see Allport: col. 11, lines 23-50; col. Del Castillo: col. 16, lines 51-61).

Regarding claim 28, Del Castillo as modified by Allport further teaches viewing and/or browsing web page or HTML data on the remote control. It is noted that this includes scrolling feature for scrolling a portion hidden from view outwardly of the display screen (see col. 12, lines 18-25).

Regarding claim 29, Del Castillo as modified by Allport further teaches a manual operation element disposed in corresponding relation to a display position of said manual operation display item on said display device (see col. 6, lines 21-39).

Regarding claim 32, Del Castillo does not teach the features of remote controller as claimed. However, a system of Allport includes a remote control 10 comprising LCD display 380 and touch screen 375 as shown in figures 1, 2 and 4 (see figures 1, 2 and 4; col. 15, lines 25-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Del Castillo by including a remote control having LCD display and touch screen as taught by Allport in order to achieve enhanced viewing and/or browsing of data on the remote control. The combined system of Del Castillo and Allport further teaches that the remote controller is configured to transmit inputted information to receiver (i.e., to swap the programs being displayed on TV and the remote control's display) (see Allport: col. 11, lines 23-50; col. Del Castillo: col. 16, lines 51-61).

Regarding claim 34, Del Castillo teaches that said peripheral device includes a toy device (60) relating to a character, wherein said toy device comprises a voice storage (within 61-67), and wherein said external control signal includes: a voice signal representative of a

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voice emitted by said character appearing in said broadcast program; and a storage command signal for instructing said toy device to store said voice signal in said voice storage (providing the control data included instructions to cause device 60 to talk as though it is a character in the audio/video presentation – see col. 11, lines 29-39; col. 16, lines 42-50).

Regarding claim 37, Del Castillo teaches transmitting combined signal in the form of a broadcasting wave for a predetermined channel (see col. 17, lines 12-24). Del Castillo does not teach the features of remote controller as claimed. However, a system of Allport includes a remote control 10 comprising LCD display 380 and touch screen 375 as shown in figures 1, 2 and 4 (see figures 1, 2 and 4; col. 15, lines 25-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Del Castillo by including a remote control having LCD display and touch screen as taught by Allport in order to achieve enhanced viewing and/or browsing of data on the remote control.

6. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Del Castillo (U.S. 6,742,188 B1) in view of Darbee (US 5,255,313 A) further in view of Allport (US 6,097,441 A).

Regarding claim 3, Del Castillo does not teach that the peripheral device is a remote controller being controlled by the command signal. However, Darbee teaches that a remote control receives code data from TV set via decoder for creating appropriate instructions for causing the IR signal output circuitry to emit IR signals which will cause specific functions to occur in specific controlled device, for operating a variety of devices to be controlled (see col. 2, lines 7-67; col. 1, lines 15-23; col. 21, lines 27-39 and figure 25). From this view, the remote control is controlled by a command signal from the TV set for outputting IR signals. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Del Castillo by including a remote control being controlled by the

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command signal from the TV set via decoder as taught by Darbee to create appropriate instructions for causing the IR signal output circuitry of the remote control to emit IR signals which will cause specific functions to occur in specific controlled device, for operating a variety of devices to be controlled.

Neither Del Castillo nor Darbee teach the features of remote controller as claimed. However, a system of Allport includes a remote control 10 comprising LCD display 380 and touch screen 375 as shown in figures 1, 2 and 4 (see figures 1, 2 and 4; col. 15, lines 25-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Del Castillo and Darbee by including a remote control having LCD display and touch screen as taught by Allport in order to achieve enhanced viewing and/or browsing of data on the remote control.

Regarding claims 4 and 5, the combined system of Del Castillo, Darbee and Allport teaches providing command signal including address and control data (see Del Castillo: col. 18, lines 1-7), displaying the embedded data on the remote control and providing control button on the remote control for user enter manual operation or input (see Allport: col. 12, lines 18-21 figures 1 and 4; Darbee: figures 1 & 15).

Regarding claim 6, Del Castillo teaches that said transmission controller comprises a multiplex element (within 76) for multiplexing said broadcast data and said external control signal into said broadcasting waves for respective channels (creating an encoded video data stream including video data and encoded control data); and a multiplex signal transmission element for transmitting said broadcasting waves for the respective channels to said receiver (transmitting the encoded video data to the receiver – see col. 14, lines 33-47; col. 17, lines 12-15).

Allowable Subject Matter

7. Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu
Primary Examiner
Art Unit 2611

February 13, 2006